

REMARKS

Claims 1-69 are pending in the Application. Claims 1-28 and 41-54 are cancelled. Claims 66-69 are new. Claims 29-40 and 55-65 are rejected under 35 U.S.C. §103(a). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request the Examiner to reconsider and withdraw these rejections. Finally, Claims 29, 30 and 55 are amended to correct typographical errors. The amendments were not made to overcome prior, were not narrowing and were not made for any substantial reason related to patentability. Therefore, no prosecution history estoppel arises. *Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

I. ELECTIONS/RESTRICTIONS

The Examiner has required restriction to one of the following inventions:

- I. Claims 1-28, drawn to a method for payment of a bill, classified in class 709, subclass 16;
- II. Claims 29-40 and 55-65, drawn to a system, classified in class 709, subclass 217; and
- III. Claims 41-54, drawn to a computer product operable for implementing a method for payment of a bill, classified in class 700, subclass 11.

Applicants' attorney contacted Examiner Gort on September 26, 2003 regarding this restriction requirement. However, no discussion on the merits transpired as Applicants understood Examiner Gort wished for any such arguments to take place in this Reply. Therefore, Applicants provisionally elect Group II, claims 29-40 and 55-65, with traverse. The restriction requirement is submitted to be improper for the reasons set forth below.

Groups I and II

The Office Action states "Inventions I and II are related as process and apparatus for its practice." Office Action, Page No. 2. Thus, the following must be

shown: "(A) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or (B) that the apparatus *as claimed* can be used to practice another and materially different process." M.P.E.P. §806.05(e)(emphasis in original).

The Office Action states "[T]he steps of calculating a bill or taking orders could be carried out by hand." Office Action, Page No. 2. However, this does not address the process "*as claimed*" and instead focuses only on certain limitations. Taking Claim 15 for example, the process "*as claimed*" includes "receiving and storing...credit card information from a...card swiped through a credit card reader" as well as "automatically calculating, by the payment unit, a balance owed...." These actions cannot be performed by hand.

Consequently, the Office Action has not met its burden of providing reasonable examples that recite material differences between the process, *as claimed*, and the apparatus. M.P.E.P. §806.05(e). Therefore, Applicants respectfully request that the Examiner withdraw the Restriction Requirement.

Groups I and III

In similar fashion to Groups I and II, the Office Action addresses Groups I and III by stating "Inventions I and III are related as process and apparatus for its practice." Office Action, Page No. 2. Again, the Office Action states "[T]he steps of calculating a bill or taking orders could be carried out by hand." Office Action, Page No. 2. However, as pointed out above, the process in Claim 15 "*as claimed*" includes "receiving and storing...credit card information from a...card swiped through a credit card reader" as well as "automatically calculating, by the payment unit, a balance owed...." These actions cannot be performed by hand. Consequently, the Office Action has not met its burden of providing reasonable examples that recite material differences between the process, *as claimed*, and the apparatus. M.P.E.P. §806.05(e). Therefore, Applicants respectfully request that the Examiner withdraw the Restriction Requirement.

Groups II and III

Finally, The Office Action states "Inventions II and III are related as subcombinations disclosed as usable together in a single combination." Office Action, Page No. 3. Thus, the following must be shown: "by way of example, that one of the subcombinations has utility other than in the disclosed combination." M.P.E.P. §806.05(d).

The Office Action states "the Invention II...could be used to perform market research, inventory tracking, or e-mail communication." However, using Claim 29 as an example, Invention II concerns "a waiter's terminal for inputting orders" with "code for computing a total amount" with a "credit card reader." Consequently, considering these elements, the Office Action has not met its burden of providing, by way of example, that one of the subcombinations has utility other than in the disclosed combination. M.P.E.P. §806.05(d). Therefore, Applicants respectfully request that the Examiner withdraw the Restriction Requirement.

II. REJECTIONS UNDER 35 U.S.C. § 103:

Claims 29-40 and 55-65 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Dorr* (U.S. Patent No. 4,530,067) in view of *Meyer et al.* (U.S. Patent No. 5,933,812) (hereafter "*Meyer*"). In response, Applicants respectfully traverse this rejection.

Independent Claim 29

Claim 29 discloses the calculation of a running balance whereas *Dorr*, *Meyer* or *Dorr* in view of *Meyer* fail to provide or suggest doing the same.

Claim 29 provides:

- "a first program code for computing a total amount owed by the plurality of patrons for the ordered food items"

- " a second program code for automatically calculating a balance owed on the total amount, wherein the balance owed equals the total amount minus the first portion"

Thus, Claim 29 "comput[es] a total amount" for the bill and then "calculate[s] a balance" that takes into account a "first portion" paid by a "first...patron." If the balance does not "equal[] zero", Claim 29 provides a "fifth", "sixth" and "seventh program code" to accommodate payments from subsequent patrons. In summary, Claim 29 allows patrons to split a bill, with minimal assistance from a waiter, by providing a running balance that is reduced with each patron's payment. For example, patron 1 can pay any portion of the total bill, then patron 2 can pay any portion of the remainder of the bill after what patron 1 paid is subtracted, and so on.

In contrast, *Dorr* fails to provide such a running balance. Despite the Office Action's position that *Dorr* provides for the "calculation of a balance owed and allowing subsequent patrons at the same table to pay until the balance is zero" (Office Action, Page No. 5), *Dorr* teaches that the waiter can split the bill on a per seat basis (e.g., seats 1 and 2 split the bill with seats 3 and 4). In such an example, the waiter then provides a bill for what seats 1 and 2 ate, while another bill is given to seats 3 and 4 for what they ate. Consequently, *Dorr* fails to provide a running balance.

In further contrast to Claim 29, *Meyer* also fails to provide a running balance. Instead, *Meyer* relies on the waiter to "carr[y] the unit to the guest's table along with the guest check showing the amount of the guest charge...." *Meyer*, 7:40-42. *Meyer* relies on the old printed "guest check" that the waiter has to walk over to the patrons. Thus, *Meyer* also fails to provide for a running balance that is reduced as patrons make contributions to the total bill.

Finally, *Dorr* in view of *Meyer* fails to provide or even suggest the calculation of a running balance. After all, *Meyer* cannot be expected to remedy *Dorr*'s shortcomings considering *Meyer* doesn't even address payment by multiple parties. Simply put, neither reference addresses calculations of a running balance whereby

patrons can more easily split a bill with minimal assistance from a waiter. Therefore, Applicants respectfully assert that the Examiner has failed to prove a *prima facie* case of obviousness in light of *Dorr, Meyer*, or even a combination of *Dorr* and *Meyer* because the references do not teach or suggest all of the elements of the claim (i.e., calculation of a running balance that is reduced as patrons make contributions to the total bill.) M.P.E.P. §2143.03; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998)(§103 rejections must not rely on incorrect factual predicates such as failing to appreciate differences between a claim and prior art.)

In addition to the calculation of a running balance, Claim 29 also provides: "a display screen on the payment unit for displaying the total amount to the plurality of patrons" and "a fourth program code for automatically displaying the balance owed on the display screen." As illustrated above, *Dorr* shows that after a customer selects a method of payment "the check is printed and totaled by check printer cash register 46 for presentation to and payment by the customers." *Dorr*, 15:16-18. *Meyer* does no better than *Dorr* on this account because *Meyer* relies on the waiter to "carr[y] the unit to the guest's table along with the guest check showing the amount of the guest charge...." *Meyer*, 7:40-42. Consequently, in *Dorr, Meyer*, or even a combination of *Dorr* and *Meyer*, the patrons never see a "display screen" that features the "total amount" or the "balance owed." Instead, they see printed guest checks. Therefore, Applicants respectfully assert that the Examiner has failed to prove a *prima facie* case of obviousness in light of *Dorr, Meyer*, or even a combination of *Dorr* and *Meyer* because the references do not teach or suggest all of the elements of the claim (i.e., displaying total and running balances.) M.P.E.P. §2143.03; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998) (§103 rejections must not rely on incorrect factual predicates such as failing to appreciate differences between a claim and prior art.)

Independent Claim 55

In a similar fashion to Claim 29, Claim 55 provides a

- "a display screen on the payment unit for displaying the total amount to the plurality of patrons"
- "a first program code for automatically calculating a balance owed on the total amount, wherein the balance owed equals the total amount minus the first portion"

Consequently, like Claim 29, Claim 55 "calculate[s] a balance" that takes into account a "first portion" paid by a "first...patron." If the balance does not "equal[] zero", Claim 55 provides a "fourth", "fifth" and "sixth program code" to accommodate payments from subsequent patrons. In summary, Claim 55, like Claim 29, allows patrons to split a bill, with minimal assistance from a waiter, by providing a running balance that is reduced with each patron's payment. As demonstrated above, *Dorr*, *Meyer* or *Dorr* in view of *Meyer* fail to provide or even suggest the calculation of such a running balance.

Claim 55, again in a similar fashion to Claim 29, also provides: "a display screen on the payment unit for displaying the total amount to the plurality of patrons" and "a third program code for automatically displaying the balance owed on the display screen." As illustrated above, in *Dorr*, *Meyer*, or even a combination of *Dorr* and *Meyer*, the patrons never see a "display screen" that features the "total amount" or the "balance owed."

In summary regarding Claim 55, Applicants respectfully assert that the Examiner has failed to prove a *prima facie* case of obviousness in light of *Dorr*, *Meyer*, or even a combination of *Dorr* and *Meyer* because the references do not teach or suggest all of the elements of the claim (i.e., calculation and display of total and running balances.) M.P.E.P. §2143.03; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998) (§103 rejections must not rely on incorrect factual predicates such as failing to appreciate differences between a claim and prior art.)

Dependent Claims 39, 40, 64, 65

Claims 39, 40, 64 and 65 are not rejectionable under §103(a) because they provide for customers to pick and choose the items for which they want to pay whereas *Dorr, Meyer* or *Dorr* in view of *Meyer* fail to provide or suggest doing the same.

Claims 39 and 64 disclose the "display screen is a touch-sensitive screen that displays a list of the food items and their respective costs." Without specific reference to *Dorr, Meyer* or any combination thereof, the Office Action provides "Touch-sensitive screens are also notoriously old and well known in the art." Office Action, Page No. 5. However, nothing in the cited prior art, alone or in combination with one another, or in the general knowledge of a person of ordinary skill in the art teaches or suggests the aforementioned claim limitations in conjunction with the limitations set out in their respective independent claims. M.P.E.P. §2143.03. The same can be said for Claims 40 and 65 wherein payment "is performed by recognizing one or more touches...of a selected one or more of the food items displayed on the touch-sensitive screen." Thus, for example only, Claims 40 and 65 allow customers to pick and choose which items they wish to pay for with minimal assistance from the waiter. The prior art, or *Dorr, Meyer* or any combination thereof, does not speak to this point of novelty.

In summary, regarding Claims 39, 40, 64 and 65, Applicants respectfully assert that the Examiner has failed to prove a *prima facie* case of obviousness in light of the prior art because the prior art does not teach or suggest all of the elements of the claim. M.P.E.P. §2143.03; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998)(§103 rejections must not rely on incorrect factual predicates such as failing to appreciate differences between a claim and prior art.)

Dependent Claim 30

Claim 30 provides "circuitry for transmitting the credit card information and payment information received by the payment unit for processing when the balance owed is equal to zero." The Office Action presumably addresses this limitation when it provides "All other claimed limitations are either disclosed or inherent." Office Action, Page No. 5. However, as indicated above, *Dorr, Meyer* or *Dorr* in view of *Meyer* fail to calculate a running balance and consequently are never "conscious" of when there is no remaining balance. Thus, *Dorr, Meyer* or *Dorr* in view of *Meyer* fail to provide for transmission of data once "the balance owed is equal to zero."

In addition, Applicants respectfully assert that the Examiner, in relying upon the theory of inherency by stating "All other claimed limitations are either disclosed or inherent", has failed to "provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d. 1461, 1464 (Bd. Pat. App. & Inter. 1990)(emphasis in original); M.P.E.P. §2112.

In summary, regarding Claim 30, Applicants respectfully assert that the Examiner has failed to prove a *prima facie* case of obviousness in light of the prior art because the prior art does not teach or suggest all of the elements of the claim. M.P.E.P. §2143.03; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998) (§103 rejections must not rely on incorrect factual predicates such as failing to appreciate differences between a claim and prior art.) Furthermore, the Examiner failed to provide reasoning to support any theory of inherency.

Dependent Claims 33, 34, 58 and 59

Claims 33, 34, 58 and 59 provide different colored lamps, located on the payment unit, that indicate whether the balance owed is equal to zero. The Office Action provides "the use of indicators are notoriously old and well known in the art of data processing to indicate to users some important state...." Office Action, Page No.

5. As previously shown, the prior art fails to calculate running balances. Thus, the lamps and their ability to illustrate whether a balance exists, when considered in light of their respective independent claims, establish a point of novelty not present in the prior art.

In summary, regarding Claims 33, 34, 58 and 59, Applicants respectfully assert that the Examiner has failed to prove a *prima facie* case of obviousness in light of the prior art because the prior art does not teach or suggest all of the elements of the claim. M.P.E.P. §2143.03; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998) (§103 rejections must not rely on incorrect factual predicates such as failing to appreciate differences between a claim and prior art.)

Claims 31, 32, 35-38, 56, 57, 60-63

Finally, presumably in response, at least in part, to Claims 31, 32, 35-38, 56, 57 and 60-63, the Office Action provides "All other claimed limitations are either disclosed or inherent." Office Action, Page No. 5. However, these claims, when considered in light of their respective independent claims, establish points of novelty not present in the prior art. Further, the Examiner has failed to specifically address there claim limitations, and thus, for this reason alone, has failed to prove a *prima facie* case of obviousness.

In summary, regarding Claims 31, 32, 35-38, 56, 57, 60-63, Applicants respectfully assert that the Examiner has failed to prove a *prima facie* case of obviousness in light of the prior art because the prior art does not teach or suggest all of the elements of the claim. M.P.E.P. §2143.03; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998).

Claims 29-40 and 55-65

In addition to the arguments set out above, Claims 29-40 or 55-65 are not rejectionable under §103 "as being unpatentable over *Dorr* ... in view of *Meyer*"

because there is no motivation to combine these sources considering they address different problems. M.P.E.P. §2143.01.

Dorr is primarily concerned with "an improved restaurant management and control system" (*Dorr*, 2:22-23) by allowing for increased efficiencies in the transfer of orders from the waiter to the kitchen, service bar, Maitre D', cash register and parking attendant. *Dorr*, 2:47-60. *Meyer* is mainly concerned with providing a "spill resistant," "portable transaction data entry terminal" that allows the guest to input data into the terminal." *Meyer*, 3:1-11.

In contrast, the present invention discloses "an ability for the bill to be split among the various patrons at a table and for each of such patrons to individually pay their desired portion using a credit card." Application, Page No. 2, lines 12-14.

Consequently, Applicants respectfully assert that the Examiner has failed to prove a *prima facie* case of obviousness in light of the prior art because there is no suggestion or motivation to modify or to combine the reference teachings. M.P.E.P. §2143.01; *In re Rouffet*, 47 U.S.P.Q.2d. 1453, 1455 (Fed. Cir. 1998) (court requires the examiner to show a motivation to combine the §103 references.).

III. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that Claims 29-40 and 55-69 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Applicants

By: _____

Kelly K. Kordzik
Reg. No. 36,571

P.O. Box 50784
1201 Main Street
Dallas, Texas 75250-0784
(512) 370-2869